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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,956	08/26/2003	Richard H. Ffrench-Constant	61,645B DIV1	5269
7590		02/15/2006	EXAMINER	
Kenneth L. Loertscher		IBRAHIM, MEDINA AHMED		
Dow AgroSciences LLC		ART UNIT		
9330 Zionsville Road		PAPER NUMBER		
Indianapolis, IN 46268		1638		

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/647,956	FFRENCH-CONSTANT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Medina A. Ibrahim	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 3 is/are allowed.
- 6) ☒ Claim(s) 4-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1 and 3-12 are pending and are examined.

#### ***Claim Objections***

At claims 4-6, it is suggested that " a genome comprising" with ---in its genome--, for clarification.

At claims 7-10, it is suggested that "A" be replaced with ---The--- because each claim refers to a previous claim.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. The claims do not read, "transgenic" seed or progeny, and therefore the claims read on the product of nature. Due to chimerism, not all of the cells from a transgenic plant will comprise in their genome the transgene.

Given that there is no indication that there would be any other distinguishable characteristics of the claimed seed/progeny, it is unclear whether the claimed seed/progeny would be distinguishable from seed/cell that would occur in nature. See *Diamond v. Chakrabarty* 447 U.S. 303 (1980), *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 76 USPQ 280 (1948), and *In re Bergy, Coats, and Malik* 195 USPQ 344, (CCPA) 1977. An Amendment to the claims to replace "Seed" with ----Transgenic seed--- in claim 11; and "Progeny of seed" with ---Transgenic progeny of the seed--- in

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claim 9 would obviate the rejection.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 4-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kramer et al (US 6, 281, 413, filed 02/17/1999).

The claims are drawn to a transgenic plant/cell having a genome comprising "a" nucleic acid sequence that encodes "a" protein of SEQ ID NO: 6. The claims are also drawn said transgenic rice, maize, cotton or tobacco/cell, seed and progeny thereof. The claims read on a transgenic plant/cell comprising in its genome a portion of any size from a nucleotide sequence encoding a portion of any size of SEQ ID NO: 6, which could be as few as 2 nucleotides.

Kramer et al teach transgenic monocot and dicot plants/cells including maize, rice tobacco and cotton transformed with nucleic acid sequences from *Photorhabdus luminescence* encoding insecticidal toxins. Kramer also teach transgenic seed and

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progeny from said transformed plants (column 15-16; 35; 46-50; claims 14-18).

Therefore, the transgenic plant/cells/~~seed~~/progeny of the prior art anticipate the claimed plant/cells/seed/progeny. Therefore, Kramer et al teach all claim limitations.

### **Remarks**

Claims 1 and 3 are free of the prior art of record.

Claims 1 and 3 are allowed.

### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571) 272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM . Before and after final responses should be directed to fax nos. (703) 872-9306 and (703) 872-9307, respectively.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Amy Nelson, can be reached at (571) 272-0804.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mai

1/31/06

MEDINA A. IBRAHIM  
PATENT EXAMINER  
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